Claims 1-44 stand rejected under 35 U.S.C. § 102(a) as allegedly anticipated by, or in the alternative under 35 U.S.C. § 103(a) as allegedly obvious over European Patent Application No. 0,925,789 (the '789 application). This rejection is improper because the '789 application is not prior art under 35 U.S.C. §§ 102(a) or 103(a).

The present application claims priority under 35 U.S.C. § 120 to U.S. Patent Application Serial No. 09/282,165 (the '165 application), and has an effective filing date of March 31, 1999. In order for a reference to anticipate under 35 U.S.C. §§ 102(a) or 103(a), its publication date must be *before* the earliest effective filing date (*see* M.P.E.P. § 706.02(a)). Therefore, because the effective filing date of the present application, March 31, 1999, precedes the publication date of the '789 application, which was June 30, 1999, the '789 application is not available as prior art to the instant application under either 35 U.S.C. §§ 102(a) or 103(a). Applicants respectfully submit that this rejection should be withdrawn.

Claims 1-29 were rejected under 35 U.S.C. § 112, ¶ 2 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states that it is unclear as to what is encompassed by the term "prevent" in claim 1, specifically whether the term of prevention is days, months, years or permanent. Applicants respectfully traverse this rejection and request reconsideration.

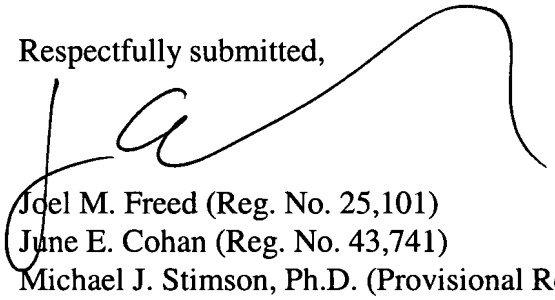
The claims are not indefinite. Compliance with the definiteness requirement of 35 U.S.C. § 112, ¶ 2, is a question of law that asks no more than if the claims, read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention. See Credle v. Bond, 25 F.3d 1566, 1576, 30 U.S.Q.P.2d 1911, 1919 (Fed. Cir. 1994). The focus of the question revolves around a reasonable understanding of one of ordinary skill in the art. See In re Miller, 441 F.2d 689, 692-93, 169 U.S.P.Q. 597, 599 (C.C.P.A. 1971). M.P.E.P. § 2173.04 recites that the "[b]readth of a claim is not to be equated with indefiniteness." The duration of prevention is not intended to limit the scope of claims 1-29. See, e.g., claim 1, which recites: "[a] process for treating an eye, which comprises: topically applying an azalide antibiotic to an eye in an amount effective to treat or prevent infection in a tissue of the eye." A person of ordinary skill in the art will know or can determine without undue experimentation the duration of prevention, which will depend on the medical state of the animal being treated. Therefore,

claims 1-29 are definite under the meaning of 25 U.S.C. § 112, ¶ 2, and the rejection may properly be withdrawn.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in condition for immediate allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. The Examiner is invited to telephone the undersigned at (202) 383-7093 with respect to any unresolved issues remaining in this application.

Respectfully submitted,



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Date: March 7, 2000

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